

REMARKS

1. Status of Application

The present application, Ser. No. 10/603,129, includes claims 26 and 32-55 and was filed on June 24, 2003. The claims have been amended as reflected in the listing of claims above. Applicant respectfully submits that the Examiner's rejections contained in the May 3, 2006 Office Action have been traversed, and therefore, that the present application is in condition for allowance.

Claims 1-22 were previously canceled, and claims 23-25, 27-31 and 37-38 are hereby canceled in this Response. Dependent claim 32 has been rewritten in independent form to include the limitations from cancelled claim 23 and also the limitation of "said shell having an external molded surface which exhibits the surface features imparted to it by a mold liner." Support for the additional limitation is found on lines 5-8 of page 10 of the specification. Except for claim 26, claims depending from original claim 23 have been canceled and the limitations originally found in those claims have been placed in new claims 46-55. Claims 46-55 depend from newly independent claim 32.

2. Claim Rejections under 35 U.S.C. § 102

a. Yan

The Examiner repeated the rejection of claims 23-25, 28-31, 35-36, 39-42 and 45 based upon 35 U.S.C. § 102(b), under U.S. Patent No. 4,960,425 to Yan et al. ("Yan"). The Examiner stated that "Yan discloses a medical article, breast implant (abstract), comprising a shell defining an interior cavity, said shell being formed of at least one layer of a non-olefin

polymer material, wherein said shell is textured (column 8, lines 5-33), seamless (column 7, lines 5-15), filled with a silicone gel, a saline solution, or a foam (column 2, lines 32-47), wherein the polymer material is silicone, polyurethane, or elastomer (column 8, line 5-33).” Applicant respectfully submits that claim 32, as presently amended, overcomes the Examiner’s rejection under 35 U.S.C. § 102(b) based on Yan. Furthermore, claims 35-36, 39-42 and 45 overcome the Examiner’s rejection under 35 U.S.C. § 102(b) based on Yan due to their dependence on claim 32.

Applicant respectfully submits that claim 32, as presently amended is not anticipated by Yan. Yan teaches only a medical article and does not teach a removable liner covering substantially all of an internal mold surface. Therefore, Yan does not teach an express limitation of claim 32 as presently amended, and it does not anticipate under 35 U.S.C. § 102(b).

Since Yan fails to anticipate limitations expressly recited by claim 32, Yan cannot anticipate the inventions recited by those claims that depend from claim 32. Therefore, claims 33-36 and 39-53 all of which depend from Claim 32, are not anticipated by Yan. Applicant respectfully requests that the Examiner withdraw the rejection of claims 35-36, 39-42 and 45.

3. Claim Rejections under 35 U.S.C. § 103(a)

a. Yan

The Examiner rejected claims 32-34 and 37-38 under 35 U.S.C. § 103(a) as unpatentable over Yan. Applicant previously withdrew claims 37-38 in Response G, mailed August 9, 2005, to June 24, 2005 Office Action and now hereby cancels these claims. Applicant respectfully submits that amended claims 32-34 are patentable over a fair reading of Yan.

The Examiner admits that Yan “does not specifically disclose a removable liner.”

Although the Examiner goes on to note that it would have been obvious to provide a removable liner for the protection of the device, Applicant respectfully urges the Examiner that neither Yan, nor any other cited prior art discloses or suggests a removable liner. Furthermore, there is no support for the use of a removable liner for the protection of the device either in the disclosure of the present application, which specifies the use of a removable liner to make the molded product seamless, or in the prior art. Applicant respectfully submits that claim 32, as presently amended is not obvious in light of Yan. Neither Yan nor any of the cited references discloses a removable liner that is adhered to substantially all of an internal mold surface. Therefore, Applicant submits that the Examiner has failed to cite a combination of prior art which discloses each and every claim limitation, which thus renders the present rejection an impermissible “obvious to try” rejection (M.P.E.P. §§ 2143.03, 2144, 2145 X.B). Nor does the Examiner cite to any teaching or suggestion in Yan, or anywhere else in the prior art, to provide a removable liner for a medical article such as the one in claim 32. (*Id.*, §§ 2143.01, 2143). As such, Applicant submits that the present rejection of claims 32-34 would also fail to meet the Examiner’s burden of producing a case of *prima facie* obviousness (*Id.*, §§ 2142, 2143). Applicant respectfully requests that the Examiner withdraw the rejection of claims 32-34.

b. Yan in view of XP-002334285

The Examiner rejected claims 27 and 43-44 under 35 U.S.C. § 103(a) as unpatentable over Yan in view of XP-002334285. Applicant submits that claim 27 has been canceled. Applicant respectfully submits that amended claims 43-44 are patentable over a fair reading of Yan and XP-002334285.

Applicant incorporates by references the arguments noted above that Yan does not anticipate claim 32, from which claims 43-44 depend. Furthermore, as noted by the Examiner, Yan fails to disclose that the shell of the prosthesis is formed from a solvent based polymer or a polymer which emits gaseous by-products during curing. XP-002334285 states that “in the production of cosmetic hand prostheses, silicone rubber dissolved in a solvent is commonly used,” and discusses the diffusion of gasses in room-temperature cured silicone. However, nowhere in XP-002334285, Yan, or the other prior art, is there any teaching or suggestion to make a medical article, such as that of claim 32, where the polymer material is solvent-based, as in claim 43, or where the polymer material emits gaseous by-products during curing, as in claim 44. Nowhere in any of the cited references is it taught that a removable liner is adhered to substantially all of an internal mold surface. Applicant respectfully requests that the Examiner withdraw the rejection of claims 43-44.

c. Yan in view of Prah

The Examiner rejected claim 26 under 35 U.S.C. § 103(a) as unpatentable over Yan in view of Prah (US 4,426,742). Applicant has amended claim 26 to rewrite this dependent claim in independent form with the limitations from now canceled claim 23. Applicant notes that the Examiner’s citation in Prah actually describes that the device has a patch in that the “adapter type molding” fits into the opening (“recess”) in the bottom of the prosthesis and functions as a patch just like other patched breast implants. Applicant therefore respectfully submits that claim 26 is patentable over a fair reading of Yan and Prah.

CONCLUSION

It is respectfully submitted that the present application is in condition for allowance and prompt notification thereof is requested. If the prosecution of this application can be advanced by a telephone conference, the Examiner is requested to call the undersigned at (212) 530-5363.

Respectfully submitted,

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